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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,414	01/29/2004	Edward O. Clapper	EC007	6971
34496	7590	11/04/2004	EXAMINER	
RICHARD C. CALDERWOOD 2775 NW 126TH AVE PORTLAND, OR 97229-8381			GUADALUPE, YARITZA	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/768,414

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Yaritza Guadalupe McCall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second set of distance marks functionally identifying positions relative to the perpendicular portion of the end piece as stated in claim 6; the inside measurement distance marks being offset along the tape from the outside measurement distance marks by a distance corresponding to the thickness of the perpendicular portion of the end piece as stated in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing

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figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 4, 6 – 7, and 9 - 10 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Bouchard et al. ( US 2,240,753 ).

In regards claim 1, Bouchard et al. discloses an apparatus comprising a housing (10) having a distal edge ( 13 ) and a proximal edge opposite said distal edge and a longitudinal exterior dimension ( defined by the graduation indicia shown in the sidewall of the housing ) from the distal edge to the proximal edge ( See Figures 1 and 2 ); and a tape ( 21, 22 ) retractably coilable within the housing ( See Figure 4 ) and extending from the distal edge of the housing through an outlet slot ( 15 ), wherein the tape includes a distal end ( 23 ), a first set of distance marks ( See upper scale indicia shown in Figure 3, representing a scale starting on zero and showing 1” as the first scale reading ) functionally identifying positions relative to the distal end, and a set of inside measure

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distance indicators ( see lower scale indicia shown in Figure 3 ) each for indicating a distance from the distal end of the tape to a corresponding distance mark plus the longitudinal exterior dimension of the housing, whereby the apparatus may be employed to perform an inside measurement whose value is indicated by the tape ( See page 2, column 1, lines 8 – 38 ).

With regards to claim 2, Bouchard also discloses the tape further including a set of outside measure distance indicators each for indicating a distance from the distal end of the tape to a corresponding distance mark; whereby the apparatus may be employed to perform an outside measurement whose value is indicated by the tape ( See page 2, column 1, lines 4 – 8 ).

Regarding claim 3, Bouchard teaches the first set of distance marks including major marks and minor marks ( as shown in Figure 3 ), and the longitudinal exterior dimension of the housing being a whole multiple of a distance between adjacent major marks, since the length of the housing represents 3 inches and the tape markings correspond to either full inches starting from zero or full inches starting from 4 inches, which takes into account the length of the housing.

In regards claim 4, Bouchard discloses an end piece ( 23 ) coupled to the tape.

Referring to claim 6, Bouchard et al. discloses an apparatus having an end piece (23) that is rigidly coupled to the tape, since the measuring tape was formed having this

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downwardly directed projection lip ( See page 1, column 2, lines 9 – 13 of Bouchard et al. ) forming a portion ( 23 ) that is perpendicular to the tape for hooking over an end of an object to be measured on the outside ( See page 2, column 1, lines 4 – 8 ); said tape further including a first and a second set of distance marks ( shown in Figure 3, and disposed on both sides of the tape ) that functionally identifies positions relative to the perpendicular portion of the end piece, since the scale indicia is provided only in the upper surface of the tape, not in the perpendicular end portion, and beginning at the distal end of the tape, allowing for an outside measurement of an object from the very edge while maintaining the tape secured to the edges of the object by means of the perpendicular end portion.

With regards to claim 7, Bouchard et al. teaches a set of outside distance indicators ( See upper scale indicia shown in Figure 3, representing a scale starting on zero and showing 1" as the first scale reading ) each for indicating a distance from the perpendicular portion of the end piece to a corresponding outside distance indicator ( See page 2, column 1, lines 4 – 8 ).

With respect to claims 9 and 10, Bouchard discloses an improved tape measure including a housing (10) having a longitudinal dimension ( as shown on the side of the housing in Figure 2) from a distal edge to a proximal edge, and a retractable tape (21, 22) having a distal end ( 23 ) and bearing distance marks and distance indicators ( See scale indicia in Figure 3 ), wherein the improvement comprises the distance indicators providing measurements from the distal end of the tape to the proximal edge of the

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housing; whereby inside measurements may be directly made with the improved tape measure without a user having add in the distance of the longitudinal dimension ( See page 2, column 1, lines 8 – 38 ); and wherein the improvement further comprises separate distance marks and distance indicators for inside measurement and for outside measurement ( See page 2, column 1, lines 1 – 4 ).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103 ( a ) as being unpatentable over Bouchard et al. ( US 2,240,753 ) in view of Usami ( US 6,032,379 ).

Bouchard et al. discloses a tape measure as stated in paragraph 2 above.

Bouchard et al. does not disclose the end piece having a predetermined distance of longitudinal slop whereby said end piece can be used in making inside and outside measurements stated in claim 5.

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With respect to claim 5 : Usami discloses a tape measure device having a measuring tape ( 1 ) having an end piece ( 2 ) coupled to the tape by means of rivets ( 3 ) provided in a pair of fastening holes ( 2c, 2d ) having an elliptical shape to allow said end portion to move left and right, and wherein this travel distance is equal to the thickness of the end piece so as to compensate for this thickness and assure an accurate zero setting of the scale when measuring inside or outside dimensions of an object ( See Column 3, lines 18 – 38 ). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bouchard et al. by replacing its end portion and connecting means with an end portion and connecting means as taught by Usami in order to increase the accuracy of the measurements by assuring an accurate zero setting of the scale ( See Column 3, lines 36 – 37 ) and allowing compensation for design parameters of the tool that may add critical inaccuracies when measuring small dimensions.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al. ( US 2,240,753 ) in view of Kuze et al. ( US 4,965,944 ).

Bouchard et al. discloses a tape measure as stated in paragraph 2 above.

Bouchard et al. does not disclose the longitudinal dimension of the housing being not an integer multiple of a distance between adjacent major marks as stated in claim 8.

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With respect to the longitudinal dimension of the housing as stated in claim 8 : Bouchard teaches a housing having a dimension of 3 inches, and having a measuring tape including a first and a second set of distance marks including major marks and minor marks ( See Figure 3 ), wherein the longitudinal dimension of the housing is being reflected in said second set of distance markings as a whole multiple of said housing dimension ( See Figure 3 ), since the second marks begins at 4 inches. Kuze et al. discloses a tape measure housing having a dimension of 3 ½ inches, so that the longitudinal dimension of the housing is not an integer multiple of a distance between adjacent major marks. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the housing disclosed by Bouchard et al. to have a dimension of 3 ½ inches as taught by Kuze et al. in order to increase the versatility of the tool by providing a bigger housing which allows for the use of a longer tape measure.

With respect to the second set of distance marks in the measuring tape : Bouchard et al. and Kuze et al. disclose a housing having a longitudinal dimension that is not an integer of multiple of a distance between adjacent major marks, and a second set of distance marks indicating a distance from the distal end of the tape to a corresponding distance mark plus the longitudinal exterior dimension of the housing, but this distance marks are shown for a housing having a longitudinal dimension of 3 inches. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify said second set of distance marks of Bouchard et al. so as to reflect the correspondent length adjustment of the housing disclosed by Kuze et al. in

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order to provide a quick measuring conversion scale that helps the user to make direct reading without the need of adding or calculating additional parameters and since Bouchard et al. already teaches the benefits of providing the alternate scales provided side by side.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al. ( US 2,240,753 ) in view of Drechsler ( US 4,574,486 ).

Bouchard et al. discloses a tape measure as stated in paragraph 2 above.

Bouchard et al. does not discloses the inside measurement distance marks being offset along the tape from the outside measurement distance marks by a distance corresponding to a thickness of the perpendicular portion of the end piece.

With respect to claim 11 : Drechsler discloses a device having a tape ( 26 ) having a first and second set of distance measurement marks ( 30, 30A ) including sets of lines or graduations ( 32 ) along the side margins of said tape, one of said distance measurement marks ( 30A ) being offset from the outer distal end of the tape or end portion ( 28 ) a predetermined distance ( Z ) which compensates for design casing parameters, i.e., distance between the tape outlet ( 22 ) and the pointer provided in the window ( 18 ) and minus the length of the bottom wall, all incurring in critical errors if not taken into account while measuring a surface or an object ( Column 3, lines 47 – 54 of Drechsler ). Therefore, it would have been obvious to a person having ordinary skill in the art at the

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time the invention was made to modify the tape disclosed by Bouchard et al. by replacing the inside measurement distance marks to be offset from the outside measurement distance marks as taught by Drechsler in order to increase the accuracy of the measurements by allowing compensation for design parameters of the tool that may add critical inaccuracies when measuring a surface or an object.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al. ( US 2,240,753 ) in view of Chilton ( US 6,684,522 ).

Bouchard et al. discloses a tape measure as stated in paragraph 2 above.

Bouchard et al. does not discloses the outside distance indicators and the inside distance indicators being enabled to share the same set of distance marks as stated in claim 12.

With respect to claim 12 : Chilton discloses a measuring tape ( 24 ) in an embodiment shown in Figure 3, comprising a conventional tape measure markings provided with distance graduations, said measuring tape being enabled to share the same set of distance marks as shown in Figure 3, with a secondary set of marking indicia (132) in the shape of diamonds for indicating studs separation distances or rafters separation along the length of the measuring tape and all provided and sharing the same distance marks ( See Figure 3 ). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the inside / outside

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scale indicia disposed on two separate scale markings disclosed by Bouchard et al. with a scale indicia sharing the same distance markings as taught by Chilton in order to simplify the reading of the tape by reducing the number of graduations which may cause confusions to the user and in order to reduce manufacturing costs.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are considered of relevance to the present application :

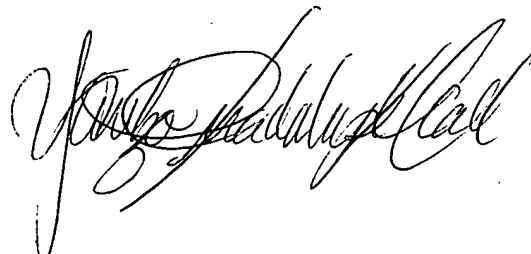
- a. McLeod ( US 1,259,886 )
- b. Mann ( US 6,138,373 )
- c. Anderson ( US 3,255,531 )
- d. Gilbert ( US 2,480,725 )
- e. Soon ( US 6,052,914 )
- f. Ljungberg ( US 2,684,534 )
- g. Quenot ( US 3,004,346 )
- h. Howle ( US 6,338,204 )
- i. Kuze et al. ( US 4,965,944 )
- j. Erdfarb ( US Pub. No. 2003/0079362 )
- k. Tarver III ( US 6,530,159 )

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe McCall whose telephone number is (571)272 -2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yaritza Guadalupe-McCall', is written over a horizontal line.

Yaritza Guadalupe-McCall  
Patent Examiner  
Art Unit 2859

YGM  
November 1, 2004